



TIPPP Meeting, October 5, 200 - Singapore

Minutes

Present: Ronald E. Myrick (REM)
Thierry Mollet-Viéville (TMV)
J. Michael Dowling (MD)
Jochen Bühling (JB)

Representatives from NRGs:
Gustavo Leonardos (Brazil)
Michel Sofia (Canada)
Detlef von Ahsen (Germany)
Pravin Anand (India)
Chew Phye Keat (Malaysia)
Charles Gielen (the Netherlands)
Russell Bagnall (South Africa)
Rubén Amengual (Spain)

1. REM welcomes the participants and announces that MD will be chairing the Task Force from now on.
2. REM reports on his latest visit to Japan, where the topic of “Privilege for IP Advisors” was also discussed. In Japan privilege is only given to people who have a certain qualification. He has asked the Japanese representatives to support a global treaty but not to propose or oppose it.

REM suggests that maybe Mexico should be the proposing country. Mr. Jorge Amigo will advocate the idea of a global treaty to WIPO.
3. MD discusses the term “privilege”. It should be made clear to the addressees that it is the privilege of the clients and not of the lawyers, patent agents or of any other profession (the IP advisors in general). The term sometimes has a negative connotation which requires further explanations.
 - a) The situation in Australia is characterized in that it does not provide for privilege protection when clients seek legal advice from overseas patent agents. Although communications between foreign lawyers and clients in Australia are privileged, this does not apply to communications to and from foreign patent agents or patent attorneys who are not also lawyers. This has

become relevant e.g. in the case *Eli Lilly v Pfizer*. In this case, privilege was denied a communication between a UK patent attorney and his client on the basis that the UK patent attorney is not a patent attorney as defined in Australia and that the privilege provided under section 200(2) of the Patents Act 1990 extends only to a patent attorney registered in Australia. MD has been part of a project by NGOs in Australia including AIPPI Australia proposing to the government to amend Sec 200 (2) of the Australian Patents Act to extend the privilege also to communications to and from a patent attorney or patent agent of another country. MD distributes the handout of the Australian NGOs' proposal to the Australian government.

- b) Michel Sofia talks about the situation in Canada. There will be a meeting with the new Commissioner of Patents. Support letters from other institutions will be welcome. However, such letters should not come from the Bar Association.

MD suggests to collect and submit to the government letters from companies who are facing the problems arising from a lack of privilege.

- c) Charles Gielen reports that the law in the Netherlands is similar to Australia. The government will put this issue on its agenda for November. In his view, the topic needs to be solved on an international level. The main question is "when is a patent attorney a patent attorney" and how the various professions from different countries should be recognized.

MD observes that the definition of the "patent advisor" is crucial. One might also consider a term along the lines of being locally qualified to give the advice for which privilege is claimed.

- d) Russell Bagnall explains that, in South Africa, in order to qualify one has to be a lawyer or attorney. Communications with independent experts are equally protected under the privilege. The problem is not so much a domestic one as rather an international problem. It has to be explained what would be the value of an international treaty for South Africa. The argument would be the contact with overseas countries.
- e) In Germany the local scene is mixed. Detlef van Ahsen reports that the government is watching the international developments. Independent experts can be a problem. The situation is not clear yet.
- f) TMV confirms that the law in France is similar to Germany.
- g) The situation in India is more complex. According to Pravin Anand the Evidence Act of 1872 is confined by the term "barrister" which is in fact outdated in practice. Therefore, the judges will decide on a case-to-case basis.

The common law doctrine of breach of confidentiality is inadequate. It will be important to educate the people about the reasons why or why not a privilege should be given in a specific case. This also comprises the definition of the "IP advisor".

A seminar to be held in February together with AIPPI is very much supported. The plan is to invite also the ministers who are involved in this topic.

- h) Chew Phye Keat explains the situation in Malaysia. There are standards for qualification. Although there is no specific protection for IP advisors, in practice protection is granted because the advisors are typically lawyers at the same time. Experts may be included indirectly. There will be a change in the office of the IP Director in Malaysia, so that new developments may be possible.
 - i) In Brazil also most patent agents are lawyers so that the problem is not yet felt there. According to Gustavo Leonardos an international treaty would nevertheless be supported. In his view India might be a better candidate for proposing the treaty to WIPO's General Assembly, since Mexico is in South America very often seen as the voice of North America.
4. It is unanimously confirmed that the problem is a live problem and needs to be addressed now.
 5. MD and JB inform the representatives about the further steps to be taken with WIPO. A draft programme has been set up and will be further discussed with WIPO in due course so that speakers and topics can be fixed.
 6. One way to attract more representatives will be to address the Council of Presidents. The goal is to include as many NRGs as possible. China should in particular be invited to name a representative.
 7. The topic of extending the privilege to communications of in-house lawyers is certainly important. JB reports on the latest decision of the European Court of First Instance of September 17, 2007 (joined cases no. T-125/03 and T-253/03) which denied privilege. AIPPI has also been approached by in-house lawyers who are concerned about the scope of the privilege. This topic will have to be dealt with at a later stage. It is not in the core of the Task Force at this point.
 8. A proposal for a first Draft Treaty will be prepared. It will probably be based on the suggested amendment of the Australian Patents Act.
 9. Further meetings will be set up in accordance with the General Secretariat. Meetings will mainly be held by way of telephone conferences.
 10. The Task Force will be assigned a Q# to fit it in with the Scientific Programme of AIPPI and to make it more visible (***note***: this has already been completed; the title is now Q199 "Privilege Task Force").

Prepared by: Jochen Bühling
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